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Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. Claims 1-18 and new claims 19 and 20 are pending.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

Claim Rejection - 35 U.S.C. §102:

All previously presented claims were rejected under 35 U.S.C. §102 as being anticipated by Tang ("ConNexus to Awarenex: Extending awareness to mobile user" article [supplied by applicant]).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants respectfully submit that the applied reference does not teach or suggest one or more elements of the claimed invention, and hence this rejection is respectfully traversed.

Claim 1:

Claim 1 is directed to a method for providing presence state information. It includes the step of "receiving first messages **from at least one switch in the public switched telephone network (PSTN) containing call event information** for at least one telephone line among a plurality of telephone lines served by the one switch".

The rejection of claim 1 is stated in paragraph 4 of the Office Action. With regard to the above quoted receiving step, it is stated that Tang discloses receiving PSTN call event information. It is also indicated that figure 9 of Tang discloses a plurality of phones connected to a telephony network through a switch. As recited in claim 1 the first message containing the call event information is received from a switch in the PSTN. Tang does not teach this limitation.

The "Awarenex Implementation" section in the right column on page 226 of Tang describes the architecture and infrastructure implementation. On the left-hand side of the Corporate Firewall in figure 9, a Corporate Intranet includes a "telephony network". It will be noted that figure 9 does not specifically illustrate a switch. However, it does contain a dialer server which is explained as being a "multiline telephone switch and is responsible for placing calls between Awarenex users and providing a speech interface to the Awarenex service". The Awarenex server and the telephone dialer server are stated to be the two main server components; see the first sentence in the "Awarenex Implementation" section. Just below the figure 9 legend it is stated, "All server components and the desktop client are written in the Java programming language." Based on these teachings of Tang, one of ordinary skill in the art would understand that the dialer server operates as a corporate intranet telephone switch controlled by Java programming language. That is, the receiving step of claim 1 is not taught by Tang.

In accordance with claim 1, the call event information is received from first messages from a PSTN switch. As explained above, the dialer server is part of a corporate intranet and does not function as a PSTN switch. This represents a substantial difference between the operation of the method in accordance with claim 1 and that of Tang. The Tang implementation has the luxury of controlling the specific interactions performed by the dialer server (corporate intranet switch) since it is written in the Java programming language that can easily be altered to accommodate the Awarenex system. As one of ordinary skill the art will understand, a PSTN switch is proprietary in terms of its operation and operating system, and hence is intentionally not made available for control by external environments. Therefore, the 35 U.S.C. 102 rejection of claim 1 is not supported by Tang and hence should be withdrawn.

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Claim 8:

Regarding claim 8, the first messages received from the PSTN switch are in PSTN compatible protocol. The Office Action states that figure 9 of Tang discloses a telephony network. It is further stated that a telephony network uses PSTN compatible protocols and therefore the first message must also use a PSTN compatible protocol. First, the "telephony network" shown in figure 9 of Tang is shown as comprising part of the Corporate Internet that is disposed behind the Corporate Firewall. A corporate telephony network such as supported by a customer owned PBX or a key telephone system does not utilize the same protocol as utilized in the PSTN. In fact, a variety of proprietary communication protocols exist based on the manufacture of such private corporate systems. Hence, it is inappropriate to assume that any messages received by the dialer server from the telephony network as shown in figure 9 of Tang have a PSTN compatible protocol.

Further, the use of a PSTN protocol in not inherent in a private telephony system as explained above.

> "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)   MPEP 2112.
> (Emphasis added.)

Where different possibilities exist with regard to the teachings of a reference, and where alternate implementations have been pointed out by applicant, it is impermissible to form a conclusion that a required element of claim is inherent given the mere fact that a certain thing may result; see above *In re Robertson.* Therefore, the rejection of claim 8 under 35 U.S.C. 102 based on Tang should be withdrawn.

Claim 9:

In claim 9, the first messages are defined as being originated by the PSTN switch. In the Office
Action, it is stated that figure 9 of Tang discloses a dialer server that acts as a phone switch.
Tang discloses that the dialer server consists of a multiline telephone switch which is part of the
corporate intranet which is controlled by Java programming. Clearly, one of ordinary skill in the
art would understand that the dialer server of Tang is not and does not function as a <u>PSTN</u>
switch. Hence, the first messages are not taught by Tang as being originated by a PSTN switch.
The 35 U.S.C. 102 rejection of claim 9 is not supported by the teachings of Tang and should be
withdrawn.

Claim 11:

In claim 11, the receiving step of claim 1 is defined as receiving the first messages by an
intelligent node in the PSTN and wherein the call event information is conveyed to the intelligent
node from the switch in native PSTN communication protocol. It is clear that the
implementation taught by Tang as explained above does not teach these requirements.

Claims 14 and 18:

Claims 14 and 18 are believed to be allowable for similar reasons discussed above with regard to
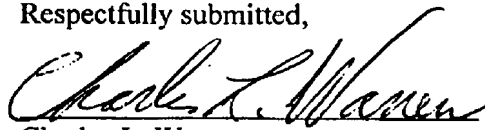claims 1 and 11.

Non-Amended Claims = non-final action

If no amendments are made to the claims, the examiner must not rely on any other teachings in
the reference if the rejection is made final. If a newly cited reference is added for reasons other
than to support the prior common knowledge statement and a new ground of rejection is
introduced by the examiner that is not necessitated by applicant's amendment of the claims, the
rejection may not be made final. MPEP 2144.03

Pursuant to MPEP 706.07(c), it would be inappropriate to make an Office Action final should new references be applied in support of a rejection of any claim that has not been amended since applicant has made no amendments to this claim to necessitate such a change of position.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,

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